

**REMARKS**

This Response is submitted in reply to the Office Action dated December 28, 2004, having a shortened statutory period set to expire March 28, 2005. Claims 1-17 are pending. No amendments to the claims have been made.

**Claim Rejections -- 35 U.S.C. § 103(a)**

On page 2 of the present Office Action, Claims 1-17 have been rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Gamble et al.*, United States Patent No. 6,233,143, in view of *Kusunoki*, U.S. Patent No. 6,370,444. That rejection is respectfully traversed and reconsideration of the Claims is requested.

Exemplary independent Claim 1 in the present application recites "sensor means" and "control means" which are interoperable such that:

*"when the carrier is inserted into the receptacle, the sensor means senses the carrier and signals the control means to actuate the drive mechanism to engage and draw the carrier into the receptacle, such that the carrier is fully seated in the receptacle"*

It is argued on page 3 of the present Office Action that these elements are disclosed by the combination of *Gamble* and *Kusunoki*. In particular, the Examiner cites col. 1, lines 12-14, col. 5, line 66 – col. 6, line 8 and col. 8, lines 6-9 of *Kusunoki* as disclosing a slit sensor 27 and MPU 33 for sensing the positioning of the carrier and repositioning the carrier according to the signal sent. The rejection goes on to further suggest that this teaching of *Kusunoki* can be combined with *Gamble* to arrive at the above-cited elements of independent claim 1. Applicants respectfully submit that nowhere does *Gamble* or *Kusunoki* provide any suggestion to combine the references in the way presented by the Examiner, nor do these references individually or in combination suggest the present invention as claimed.

First, neither *Gamble* nor *Kusunoki* describe a drive mechanism mounted within the receptacle having the capability to "engage and draw the carrier into the receptacle, such that the carrier is fully seated in the receptacle" as is recited in exemplary claim 1. For example, *Gamble* described a carrier for hot-pluggable hard disc drive having a frame. *Gamble*

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further describes the capability of inserting such carrier 11 into system 71 by manual insertion and seating of the carrier into the rectangular docking base 73 (see col. 1, lines 51-57 and col. 3, lines 5-37). *Kusunoki* only teaches a motor-drive to move the carrier in a vertical direction, not into a receptacle (See col. 6, lines 1-67). *Kusunoki* teaches that the drive mechanism is engaged to move the carrier along guide shaft 15 in response to the sensor means. Moving the carrier along the vertical guide shaft 15 in no way shows or suggests the actuation of the drive mechanism to **“engage and draw the carrier into the receptacle, such that the carrier is fully seated in the receptacle”** as is recited in exemplary claim 1 of the present application. Consequently, the Examiner’s suggested combination of *Gamble* and *Kusunoki* fails to provide the requisite suggestion to arrive at the present invention.

Second, *Kusunoki* teaches a disc library apparatus having shelves for storing discs and at least one disc drive for accessing information on the discs. A motor-driven carrier transports discs between the shelves and the drive. *Kusunoki* teaches the use of sensors for detecting the position and presence of a disc and disc drives. In particular, MPU 33 moves the carrier 13 from its current position to the n-th shelf position as determined by counting slits detected by the slit sensor 27, then halts the carrier 13 and activates the picker motor 25 (see col. 5, lines 10-15). The carrier 13 is equipped with a slit sensor 27 that senses the positions of the slits 9 in the slit plate 7 (col. 4, lines 9 – 10). Slit sensor 27 is not sensing the carrier. Instead, *Kusunoki* is teaching sensing a position of the carrier with respect to slit 9. Sensor 29 senses the presence of a disc contained within a shelf of magazine 5 or ejected from the drives 11 as shown in Figure 2 (col. 4, lines 18-29). Thus, what *Kusunoki* teaches is a sensor means for sensing the position of the carrier to issue commands to the carrier to move upward or downward to a drive or shelf position. (See col. 6, lines 1-67). *Kusunoki* does not suggest **“when the carrier is inserted into the receptacle, the sensor means senses the carrier and signals the control means to actuate the drive mechanism to engage and draw the carrier into the receptacle”** as is recited in exemplary claim 1 of the present application. Consequently, the Examiner suggested combination of *Gamble* and *Kusunoki* fails to provide the requisite suggestion to arrive at the present invention.

### **OBVIOUSNESS IN HINDSIGHT**

The present invention is directed to a mechanism for automatically drawing a carrier into a disc drive and seating it within a receptacle of the disc drive. *Gamble* describes a manual process for inserting and seating a carrier in a disc drive. *Kusunoki* nowhere describes inserting or seating the carrier anywhere within the disc drive. Instead, *Kusunoki* teaches a carrier system for moving discs between a shelf storage and a disc drive. Nowhere does *Kusunoki* teach drawing a carrier into a disc drive or a receptacle thereof as is claimed in the present invention. Without the use of improper hindsight of the present application to automate the insertion process of *Gamble*, Applicants respectfully submit that there appears to be no reasonable way to combine the references as suggested by the Examiner to arrive at the present invention. "Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention." *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998)." *Crown Operations International, Ltd. V. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002)

To guard against the use of such impermissible hindsight, the law requires that obviousness needs to be determined by ascertaining whether the applicable prior art contains any suggestion or motivation for making the modifications in the design of the prior art article in order to produce the claimed design. Even the mere possibility that a prior art teaching could be modified or combined such that its use would lead to the particular limitations recited in a claim does not make the recited limitation obvious, unless the prior art suggests the desirability of such a modification. *See In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed Cir. 1984). Thus, applicants specifically request that these obviousness rejections be withdrawn, or that a reference or references, including the required motivation to modify or combine in a manner that achieves the claimed subject matter be provided in support thereof.

**CONCLUSION**

In summary, neither *Gamble* nor *Kusunoki*, nor any combination thereof, shows or suggests sensing means for determining when the carrier has been inserted into the receptacle, or control means for actuating a drive mechanism to engage and draw the carrier into the receptacle upon the sensor sensing the carrier within the receptacle. Consequently, Applicants respectfully request reconsideration of the rejection of Claim 1 for the reasons given above. Similarly, Applicants respectfully request reconsideration of Claims 2-17 for the reasons given above and submit that the rejection under §103 should be withdrawn.

Respectfully submitted,



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